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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/683,946 | 10/10/2003 | Gerard P. Nikodem | 20722-1 | 2770 |
| 7590 01/22/2007 John S. Beulick Armstrong Teasdale LLP Suite 2600 One Metroplitan Square St. Louis, MO 63102 | | | EXAMINER ROSS, DANA | |
| | | | ART UNIT 3722 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/22/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/683,946 | Applicant(s) NIKODEM, GERARD P. | |
| | Examiner Dana Ross | Art Unit 3722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-9 and 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 8, 9, 11, 12 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Burke et al. (5,716,688).

Regarding claims 8 and 12, Burke et al. disclose a security tag (5) used to conceal information comprising a first portion (10) with first side (17) secured to a medium (Col. 3, lines 45-55) and second side (16) coupled to second portion (100D). The first portion comprising two ends and a body between (See figure 3).

Regarding claim 9, Burke et al. disclose the second portion as being separately removable from the tag (See figure 4).

Regarding claim 11, Burke et al. disclose the information being contained on the inner surfaces for the first and second portion (Col. 2, lines 55-57).

Regarding claim 14, when the second portion is removed from the tag, an opening is formed in the tag (See figure 4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6, 7, 13, 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. in view of Ritter (2,363,472).

Burke et al. disclose the claimed invention except for placing the security tag on a postcard. They do disclose that the security tag can be placed on a pliable surface (Col. 1, lines 35-48). Ritter teaches putting such a security tag on a postcard. It would have been obvious to one of ordinary skill in the art at the time of the invention to place Burke et al.'s security tag on a postcard to conceal information.

Regarding claims 1, 2, 4, 6 and 7; see the above rejections for claims 8, 9, 14, 11 and 12 respectively.

Regarding claims 15-17 and 19, Ritter, in conjunction with Burke et al., disclose the claimed method as set forth in the above rejections to claims 1 and 4.

Regarding claims 3, 13, 18 and 20-24, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sections of the security tag of any required material depending on the result desired by the end user, since it has been held to within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

In re Leshin, 125 USPQ 416.

Response to Arguments

5. Applicant's arguments filed 14 October 2005 have been fully considered but they are not persuasive.

Examiner appreciates the detailed explanation of the differences between the prior art and Applicant's invention. Examiner notes that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant asserts that claim 8, and therefore the dependent claims, is not anticipated by Burke.

Examiner notes that the limitations of the independent claim 8 are broad in nature.

For example, Applicant claims a tag with first and second portions, with no actual structural limitations to the portions or inner or outer surfaces. Burke teaches several different portions (see figure 2, for example) with the claimed limitations of the inner and outer surfaces. These portions are all interconnected, and depending on which is considered the first or second portions and their various connection means and meet the limitation of the generic "first portion" secured to the medium "with a bond that is stronger than a bond used to secure said second portion" to the medium.

Regarding claims 8, 9, 11, 12 and 14, Applicant asserts that Burk does not disclose the first portion secured to the writing medium "with a bond that is stronger than a bond used to secure said second portion to the writing medium". Applicant asserts that Burke teaches "the adhesive of the first ply is a temporary adhesive and the adhesive on the second ply is greater

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than the adhesive of the first ply". Examiner disagrees and maintains that the first portion is secured to the medium with a bond that is stronger than the bond used to secure the second portion to the medium (see col. 3, lines 45-55).

Applicant asserts that claims 1-4, 6, 7, 13 and 15-24 are not obvious over Burke in view of Ritter.

Applicant is referred to the above discussion of Burke.

Applicant states there is no motivation found to combine Burke with Ritter. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant appears to assert that the choice of material used is not an obvious design choice. Examiner disagrees and refers Applicant to the above motivation statement which is reiterated here for clarity that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sections of the security tag of any required material depending on the result desired by the end user, since it has been held to within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Applicant further asserts the same argument to the remaining claims. Applicant is referred to the above discussion of Burke.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dana Ross
Examiner
Art Unit 3722



dmr